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 KEATING DENTAL ARTS, INC.

IN THE UNITED STATES DISTRICT COURT
 FOR THE CENTRAL DISTRICT OF CALIFORNIA
 SOUTHERN DIVISION

JAMES R. GLIDEWELL DENTAL
 CERAMICS, INC. dba GLIDEWELL
 LABORATORIES,

Plaintiff,

v.

KEATING DENTAL ARTS, INC.

Defendant.

AND RELATED COUNTERCLAIMS.

Civil Action No.
 SACV11-01309-DOC(ANx)

**KEATING'S OPPOSITION
 TO GLIDEWELL'S MOTION
 FOR PARTIAL SUMMARY
 JUDGMENT AS TO
 KEATING'S INVALIDITY
 DEFENSE AND
 COUNTERCLAIM**

Honorable David O. Carter

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1 Defendant Keating Dental Arts, Inc. hereby submits its opposition to
2 Plaintiff James R. Glidewell Dental Ceramics, Inc. dba Glidewell Laboratories’
3 (“Glidewell”) Motion for Partial Summary Judgment as to Invalidity Defense
4 and Counterclaim.

5 **I. INTRODUCTION**

6 Glidewell admits that its BruxZir crown is “a crown for bruxers,” that “it
7 stands for bruxism and zirconia,” and “if you see brux or you identify somebody
8 with bruxism. Think of zirconium. So we put brux and zir together.” But
9 Glidewell did not disclose that to the trademark Examiner. Nor did Glidewell
10 disclose that “BruxZir” is phonetically equivalent to “bruxer,” the generic term
11 for the intended user of Glidewell’s BruxZir crowns. The trademark
12 examiner—who is not a dentist—did not do a routine Internet search and did not
13 follow the usual practice of asking if the term had any meaning in the industry.
14 The undisputed evidence of widespread use in the dental industry of “brux,”
15 “bruxer,” and “zir” is more than sufficient to rebut the presumption of validity,
16 and also establishes that Glidewell’s mark should be canceled as a matter of
17 law. Because Glidewell chose a misspelling of a generic term for its mark, no
18 amount of advertising or sales can save the mark.

19 Moreover, Glidewell did not conduct a survey and did not produce any
20 other evidence establishing that, in the minds of a significant number of relevant
21 consumers, the *primary significance* of the mark is to signify Glidewell and not
22 the product itself. Glidewell instead resorts to mischaracterizing the testimony
23 of Keating’s witnesses and providing late declarations from dentists who are
24 Glidewell customers and were first disclosed *seventeen minutes before*
25 *Midnight on Discovery Cutoff, October 29, 2012*. Keating had no opportunity
26 to depose these witnesses. Furthermore, Glidewell submitted only one timely
27 expert report—from a law Professor named David Franklyn. Glidewell did not
28 submit any timely rebuttal reports on the October 15, 2012 deadline. Despite

1 the Court's order denying Glidewell's request for extension of discovery and
2 other deadlines, Glidewell's motion relies upon declarations from Professor
3 Franklyn and a dentist, Dr. Goldstein, based upon untimely rebuttal reports
4 submitted two weeks after the October 15 deadline, and minutes before
5 Midnight on the Discovery Cutoff. The Franklyn and Goldstein declarations are
6 therefore inadmissible. The opinions set forth in the declarations regarding
7 dentists' perceptions are also inadmissible because they constitute hearsay and
8 fail to follow rigorous standards required for admissible survey data. The
9 Franklyn declaration also directly contradicts his prior deposition testimony, in
10 which he stated that he had "*not spoken to any dentists about anything other*
11 *than my own teeth and my own bruxer crown.*"¹

12 At the very least, Glidewell's mark is merely descriptive (rather than
13 suggestive) and not protectable without secondary meaning. No mental leap of
14 imagination is required. Dentists immediately know that brux means brux or
15 bruxism and zir means zirconia, and that is precisely the reason Glidewell chose
16 the mark. Moreover, Glidewell has failed to establish secondary meaning by
17 failing to submit a secondary meaning survey, failing to timely identify any
18 dentist witnesses to support secondary meaning in its mark, and failing to
19 submit any evidence regarding the effect of its advertising and sales on the
20 relevant consumers, dentists. Glidewell's declarations from seven previously
21 undisclosed dentists are not admissible and entitled to no evidentiary weight.
22 None of the dentists' names were disclosed to Keating until seventeen minutes
23 before Midnight on the Discovery Cutoff date, they are all Glidewell customers
24 and have, some have as recently as last month, toured Glidewell's facility. Such
25 evidence, in addition to being untimely, falls far short of the rigorous secondary

26
27 ¹ Keating objects to the Declaration and Report of Dr. Goldstein and
28 Declaration and Reports of David Franklyn in separate Objections submitted
herewith.

1 meaning evidence that Glidewell is required to establish to prove a protectable
2 mark.

3 Keating has presented undisputed facts demonstrating that the BruxZir
4 mark is invalid as a matter of law. (*See* Keating's Mtn. to Cancel Glidewell's
5 Registration (Docket Nos. 83, 85, 87). This evidence is more than sufficient to
6 rebut the presumption of validity. Indeed, it is sufficient to show that
7 Glidewell's mark is not entitled to trademark protection and should be canceled.

8 Accordingly, Keating respectfully requests that the Court deny
9 Glidewell's motion.

10 **II. SUMMARY JUDGMENT STANDARDS**

11 For those issues on which Glidewell bears the burden of proof, Glidewell
12 must present evidence satisfying its burden of proof, and must show that the
13 evidence is so powerful that no reasonable jury would be free to disbelieve it.
14 *Shakur v. Schriro*, 514 F.3d 878, 890 (9th Cir. 2008); *Watts v. United States*,
15 703 F.2d 346, 347 (9th Cir. 1983); 11 *Moore's Federal Practice* § 56.13[1] at
16 56-166 (3rd ed. 2009). For those issues on which Keating bears the burden of
17 proof, Glidewell must demonstrate that the record lacks any substantial evidence
18 in Keating's favor on those issues. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-
19 324, 106 S.Ct. 2548, 91 L.Ed. 2d 265 (1986). As Keating is the non-movant,
20 the Court must draw all inferences in Keating's favor. *Japan Telecom, Inc. v.*
21 *Japan Telecom Am., Inc.*, 287 F.3d 866, 872 (9th Cir. 2002). Glidewell cannot
22 meet its burden on this motion.

23 **III. KEATING HAS PRESENTED MORE THAN SUFFICIENT** 24 **EVIDENCE TO REBUT THE PRESUMPTION OF VALIDITY**

25 **A. Keating's Evidence Meets The Preponderance of Evidence Standard**

26 When a trademark has been registered, the defendant has the burden of
27 proving that its registration is defective or subject to a defense. The defendant
28 must show such defect or defense by a preponderance of the evidence. 15

1 U.S.C. § 1115(b); *Sengoku Works Ltd. v. RMC Int'l., Ltd.*, 96 F.3d 1217, 1219-
2 20 (9th Cir. 1996); *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769,
3 775-76 (9th Cir. 1981); *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th
4 Cir. 2002). Keating has presented more than sufficient evidence to rebut the
5 presumption.

6 As the Ninth Circuit stated in *Zobmondo Entm't*:

7 “[A]ssuming the defendant can demonstrate through law, undisputed
8 facts, or a combination thereof that the mark is invalid, the evidentiary
9 bubble [created by the federal registration] bursts and [Glidewell] cannot
10 survive summary judgment. In the face of sufficient and undisputed facts
11 demonstrating [invalidity], the registration loses its evidentiary
12 significance.”

13 *Zobmondo Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1115 (9th Cir.
14 2010), citing *Tie Tech*, 296 F.3d at 783 (“In trademark terms, the registration is
15 not absolute but is subject to rebuttal”); see also *Talking Rain Beverage Co. v. S.*
16 *Beach Beverage Co.*, 349 F.3d 601, 603 (9th Cir. 2003); *America Online, Inc. v.*
17 *AT&T Corp.*, 243 F.3d 812, 818 (4th Cir. 2001); *Retail Servs., Inc. v. Freebies*,
18 364 F.3d 535, 543 (4th Cir. 2004) (If sufficient evidence of genericness is
19 produced to rebut the presumption, the presumption is “neutralize[d]” and
20 essentially drops from the case, although the evidence giving rise to the
21 presumption remains), citing *America Online*, 243 F.3d at 818.

22 The presumption afforded a registered trademark assumes that the PTO
23 has properly examined the trademark. See *Zobmondo Entm't*. (“[d]eference to
24 the PTO’s classification decision is sensible because the PTO has special
25 expertise that we lack on this fact-intensive issue.”). 602 F.3d at 1115. Such
26 deference necessarily assumes that the trademark examiner has reviewed facts
27 upon which to render a deferential classification of suggestiveness rather than
28 genericness or mere descriptiveness.

1 No such facts were before the Examiner of Glidewell's application for the
 2 mark BruxZir. Indeed, the Examiner failed to follow the usual procedure, as
 3 recommended in the Trademark Manual of Examining Procedure, §§ 814 and
 4 1209.2, to ask if the term had any meaning in the industry. (Keating SOF ¶ 90-
 5 91, 94; Boatright Decl., Ex. A ¶ 44.). Nor did Glidewell voluntarily offer any
 6 such information. (Keating SOF ¶ 94.).

7 As the Examiner is not a dentist, she could not have known that, to the
 8 relevant purchasing public—dentists—"brux" means teeth grinding and "zir"
 9 means zirconia. (Keating SOF ¶¶ 4-5, 60.) Nor was she aware that the mark
 10 sounds phonetically identical to "bruxer," the intended user of Glidewell's
 11 dental crowns (Keating SOF ¶¶ 47-53, 6-8), among the goods listed in
 12 Glidewell's application, and as referenced in Glidewell's marketing materials
 13 ("ideal for bruxers."). (Keating SOF ¶¶ 40, 44-46.)

14 **B. The Undisputed Evidence Shows Glidewell's Mark Is Generic**

15 **1. Glidewell Ignores Undisputed Evidence That BruxZir Is**
 16 **Phonetically Equivalent To And A Misspelling of Bruxer**

17 Notably, Glidewell ignores the undisputed evidence of phonetic
 18 equivalency of its mark with the term "bruxer," which Glidewell admits is the
 19 generic name for a person who bruxes and the intended user of Glidewell's
 20 BruxZir crowns. (Keating SOF ¶ 39-46.) As the phonetic equivalency of the
 21 generic name for the intended user of its BruxZir product, the mark is generic as
 22 a matter of law. *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1186 n.24 (5th
 23 Cir. 1980) ("Plaintiff's using the phonetic equivalent of the generic term
 24 'larvicide' in its mark 'Larvacide,' i.e., misspelling it, does not render the mark
 25 protectable." (citing *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d
 26 75, 79 (7th Cir. 1977)) ("Using the phonetic equivalent of a common descriptive
 27 word, i.e., misspelling it, is of no avail.").

28 ///

1 The evidence submitted with Keating's motion establishes beyond any
 2 doubt that the BruxZir mark is pronounced identically to "bruxer." (Keating
 3 SOF ¶ 47-53.) This includes Glidewell's own promotional videos, and video
 4 recorded witness testimony. (Keating SOF ¶ 47-49.) Glidewell put "brux" and
 5 "zir" together so that dentists would know immediately what it was, "***a crown***
 6 ***for bruxers.***" (Keating SOF ¶ 33.)

7 Glidewell's adoption of a misspelling of "bruxer" for its mark, and
 8 assertion of its BruxZir mark against competitors using "brux" and "bruxer" is
 9 evidence of genericness because it deprives competitors of the right to identify
 10 their products as intended for bruxers. *Nupla Corp. v. IXL Mfg. Co.*, 114 F.3d
 11 191, 196 (Fed. Cir. 1997); *Cont'l Airlines Inc. v. United Air Lines Inc.*, 53
 12 U.S.P.Q.2d (BNA) 1385, 1999 WL 1288981 (TTAB 1999); *Retail Servs.*, 364
 13 F.3d 535.

14 **2. Glidewell Admits Its BruxZir Crowns Are For Bruxers**

15 Glidewell's admits that its BruxZir crowns are intended for bruxers.
 16 (Keating SOF ¶ 39-46.) In addition, Glidewell's marketing materials repeatedly
 17 state that its crowns are "ideal for bruxers." (Keating SOF ¶ 40, 45-46.)

18 Glidewell's witnesses admitted that they chose the mark specifically
 19 because dentists recognized the meaning of "brux" and "zir" and because the
 20 product was intended for bruxers. (Keating SOF ¶ 30-38.)

21 **3. Glidewell Has Failed To Establish That The Primary** 22 **Significance Of Its Mark Is To Identify Glidewell**

23 As Glidewell admits, in determining whether a mark is distinctive and
 24 entitled to trademark protection, the Court is "required to consider standards of
 25 meaning not [its] own, but prevalent among prospective purchasers of the
 26 article." *Zobmondo Entm't*, 602 F.3d at 1113 (citation omitted). "[I]f the
 27 primary significance of the trademark [to the prospective purchaser] is to
 28 describe the type of product rather than the producer, the trademark [is] a

1 generic term and [cannot be] a valid trademark. *Filipino Yellow Pages, Inc. v.*
 2 *Asian Journal Publs., Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (citation
 3 omitted).

4 Glidewell must “show that the *primary significance* of the term in the
 5 minds of the consuming public is not the product but the producer.” This it has
 6 not done. *Filipino Yellow Pages*, 198 F.3d at 1147; *Kellogg Co. v. National*
 7 *Biscuit Co.*, 305 U.S. 11, 118-119, 59 S. Ct. 109, 83 L. Ed. 73.

8 **a. Glidewell Failed To Produce A Survey**

9 Surveys are commonly used to probe customer perceptions as to the
 10 generic-trademark dividing line. MCCARTHY ON TRADEMARKS, 4TH EDITION,
 11 § 12:14 et seq. Glidewell did not identify any survey evidence during discovery
 12 indicating that the primary significance of its mark in the minds of relevant
 13 purchasers is to identify Glidewell, rather than its product. Keating requested
 14 such evidence, but Glidewell stated it had “None.” (2nd Jankowski Decl., Ex.
 15 141. Moreover, Glidewell’s legal expert, Professor Franklyn, also testified that
 16 he was not aware of any survey of dentists and had not spoken to any dentists in
 17 connection with this case. (“**I have not spoken to any dentists about**
 18 **anything other than my own teeth and my own bruxer crown.**”) (2nd
 19 Jankowski Decl., Ex. 153 (Franklyn Dep. Tr.), at 133:6-8)

20 Although not required, survey evidence has become “de rigueur” in cases
 21 involving genericness of trademarks. *In Hyuk Suh v. Choon Sik Yang*, 987 F.
 22 Supp. 783, 791 (N.D. Cal. 1997). The absence of a survey from Glidewell,
 23 particularly in view of Glidewell’s financial ability to conduct a survey, raises
 24 the inference that such a survey would not have been favorable to Glidewell.
 25 *See Playboy Enters. V. Netscape Commc’ns. Corp.*, 55 F. Supp. 2d 1070, 1084
 26 (C.D. Cal. 1999); *Cairns v. Franklyn Mint Co.*, 24 F.Supp. 2d 1013, 1041-42
 27 (C.D. Cal. 1998) (“[A] plaintiff’s failure to conduct a consumer survey,

28 ///

1 assuming it has the financial resources to do so may lead to an inference that the
2 results of such a survey would be unfavorable.”).

3 In view of the overwhelming evidence showing widespread third party
4 use of “brux,” “bruxer” and “zir,” the phonetic equivalency of “BruxZir” and
5 “bruxer”, as well as Glidewell’s own generic use of its mark and uncontrolled
6 use of the mark by competitor dental labs (Keating SOF ¶¶ 60-61, 47-53, 54-59,
7 64-69), Keating does not need to produce a survey in order to prove that
8 Glidewell’s mark is generic. *Nartron Corp.*, 305 F.3d 397, cert. denied, 123 S.
9 Ct. 1486, 155 L.Ed. 2d 227 (2003) (“Thus, the overwhelming evidence in this
10 case obviates the need for [defendant] to have conducted a consumer survey.”)
11 *Colt Defense LLC v Bushmaster Firearms, Inc.*, 486 F.3d 701 n.4 (1st Cir.
12 2007) (term was found to be a generic name without the need for a survey).

13 **b. Keating Has Provided Substantial Evidence That**
14 **Dentists Use The Word “BruxZir” As A Generic**
15 **Reference To A Type of Crown**

16 Keating has submitted a timely expert report from Dr. Eggleston
17 (Eggleston Decl., Ex. 64) and declarations from thirteen dentists that have
18 written “BruxZir,” or variations thereof on prescription forms as a generic
19 reference to an all-zirconia crown. (See Belton Decl., ¶ 9-11; Brady Decl., ¶ 9-
20 11; Campbell Decl. 9-12; Colleran Decl. ¶ 10-12; Jacquinet Decl. ¶ 9-10;
21 Murphy Decl. ¶ 9-11; Myers Decl. ¶ 9-10; Nussear Decl. ¶ 9-11; Richardson
22 Decl. ¶ 10-12; Scott Decl. ¶ 9-11; Stephens Decl. ¶ 10-12; Sweet Decl. ¶ 8-10;
23 Tobin Decl. ¶ 9-11). Keating has also submitted a declaration from a third party
24 dental lab unaffiliated with Glidewell or Keating, Showcase Dental Laboratory,
25 that also receives (and fills) orders from dentist-customers who write “BruxZir”
26 on prescription forms as a generic reference to an all-zirconia crown. (See
27 Frattura Decl., ¶¶ 6-9, 18.) Keating has also submitted substantial evidence

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1 showing widespread third party use of the terms “bruxer” and “brux” in
2 connection with dental crowns. (Keating SOF ¶¶ 60-62.)

3 **c. Glidewell’s Testimony And Use Establishes Genericness**
4 **Of The Mark**

5 Glidewell relies upon the declarations of its employees Jim Shuck, Dr.
6 Micael DiTolla, and Rudy Ramirez. [Mot. 10-11]. Keating has objected to
7 these declarations (*see* Keating Objections to Evidence submitted herewith).

8 Such self-serving declarations from Glidewell’s employees are entitled to
9 little weight. They do not establish, as required by law, that the *primary*
10 *significance* of the mark in the minds of the relevant purchasing public is to
11 identify Glidewell as the source of the product. *Japan Telecom*, 287 F.3d at
12 873.

13 Mr. Shuck testifies about Glidewell’s sales and advertising expenses.
14 And states that “the term ‘bruxzir’ is not used by Glidewell—or, to my
15 knowledge, widely or generally used by anyone else – to refer to sold zirconia
16 crowns. [Mot. At 11, SUF 15). Not only does this testimony lack foundation
17 and constitute hearsay and speculation, it is directly contrary to the undisputed
18 evidence. Glidewell’s own videos use the term ‘bruxzir’ pronounced identically
19 to ‘bruxer’ to refer to sold zirconia crowns, often as a noun for the product, not
20 to identify Glidewell as the source. (Keating SOF ¶¶ 47-48, 57.) In addition,
21 presentations by Glidewell employees establish Glidewell’s own generic use of
22 the term “BruxZir.” Dr. DiTolla even states “one can even get a couple of
23 BruxZirs put in”. (Keating SOF ¶ 58.) Such evidence of the owner’s generic
24 use “is strong evidence of genericness.” MCCARTHY ON TRADEMARKS, 4TH
25 EDITION, § 12:13.

26 Furthermore, Glidewell has focused its advertising and promotion on
27 teaching the dental community that the BruxZir mark *is not an indication of*
28 *Glidewell as the source*. (Keating SOF ¶¶ 54-59, 64-69.) Glidewell and many

1 other dental labs use the word BruxZir to convey *what* the product is rather than
 2 *who* is the source of the product. (Keating SOF ¶¶ 64-69.) The undisputed
 3 evidence indicates that, when applied to a dental restoration, the term BruxZir
 4 immediately conveys to dentists a zirconia product made to be used with
 5 bruxers. (Belton Decl.; Brady Decl.; Campbell Decl.; Colleran Decl.; Jacquinet
 6 Decl.; Murphy Decl.; Myers Decl.; Nussear Decl.; Scott Decl.; Stephens Decl.;
 7 Sweet Decl.; Tobin Decl.; Keating SOF ¶¶ 72-73, 75-78; Eggleston Decl., Ex
 8 65 at 12, 14-18; Eggleston Decl., Ex. 66 at 3-5; Eggleston Decl., Ex. 67 at 3-7;
 9 Frattura Decl. at ¶¶ 7-9, 18.)

10 **4. Keating's Alternative Argument of Mere Descriptiveness Does**
 11 **Not Constitute An Admission Of Non-Genericness**

12 Highlighting the weakness of its non-genericness argument, Glidewell
 13 relies on Keating's Petition for Cancellation in which Keating made the
 14 alternative argument, that—if not generic—Glidewell's mark is at least merely
 15 descriptive. Alternative arguments do not constitute admissions. *Maloney v.*
 16 *Scottsdale Ins. Co.*, 256 Fed. Appx. 29, 31 (9th Cir. 2007); Fed. R. Civ. P.
 17 8(d)(2)-(3). Indeed, it is common in trademark genericness cases to make an
 18 alternative argument of descriptiveness without secondary meaning. The
 19 court's ability to find a mark generic is certainly not abrogated by an alternative
 20 argument that the mark is descriptive. *See CG Roxane LLC v. Fiji Water Co.*
 21 *LLC*, 569 F. Supp. 2d 1019 (N.D. Cal. 2008) (holding mark generic after
 22 considering alternative genericness and descriptiveness arguments); *Classic*
 23 *Foods Int'l Corp. v. Kettle Foods, Inc.*, 468 F. Supp. 2d 1181 (C.D. Cal. 2007)
 24 (holding mark generic after considering alternative genericness and
 25 descriptiveness arguments); *Filipino Yellow Pages*, 198 F.3d 1143 (holding
 26 mark generic after considering alternative genericness and descriptiveness
 27 arguments).

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1 **5. Keating's Awareness of Glidewell's Trademark Registration Is**
 2 **Not Evidence Of Distinctiveness In Glidewell's Mark**

3 Glidewell grossly mischaracterizes the testimony of Keating's witnesses
 4 to argue that their awareness of Glidewell's registration and actions since the
 5 filing of the suit somehow is evidence of the validity of Glidewell's mark.
 6 (Mot., pp. 7-9). Under Fed. R. Evid. 407, evidence of actions taken by
 7 defendants taken to reduce potential liability cannot be relied upon as an
 8 admission. *Interactive Health LLC v. King Kong USA, Inc.*, CV06-1902, 2008
 9 U.S. Dist. LEXIS 123559, *20 (C.D. Cal. July 24, 2008) (excluding evidence
 10 offered by plaintiffs of defendants' sale of different products in lieu of accused
 11 models); *Avery Dennison Corp. v. Acco Brands, Inc.*, CV99-1877, 1999 U.S.
 12 Dist. LEXIS 21464, 22 (C.D. Cal. Oct. 12, 1999) (excluding evidence offered
 13 by plaintiffs of defendant's change in its packaging).

14 **a. Glidewell Mischaracterizes Keating's Prescription Forms**
 15 **And Internal Documents As Admissions of Validity**

16 After being sued by Glidewell in this lawsuit, Keating initiated a policy of
 17 calling dentists who wrote "BruxZir" or variations thereof on their prescription
 18 forms submitted to Keating to (1) educate the dentists as to the existence of
 19 BruxZir as a trademark of a competing dental lab, and (2) to confirm that the
 20 dentists wanted Keating's all-zirconia crown, and not another dental lab's
 21 product. (Keating SOF ¶¶ 72-75.) Keating implemented this policy because it
 22 had been sued by Glidewell, and it wanted to ensure that it did not mistakenly
 23 fulfill any prescriptions from dentists wanting to purchase an all-zirconia crown
 24 from Glidewell. (Mangum Decl., Ex. 53 (Brandon Dep. Tr.), at 47:12 – 48-20).
 25 In its motion, Glidewell mischaracterizes Keating's policy as an admission by
 26 Keating as to the validity of Glidewell's mark. (Mot. at 7-9). As part of its
 27 policy, Keating had its employees inform each dentist who wrote "BruxZir," or
 28 variations thereof, on their prescription forms that a competing dental lab has a

1 registered mark in the name BruxZir. (Keating SOF ¶ 74.) That is a factual
2 statement, not a party admission as to the validity of Glidewell's registration.

3 Every time, the dentists confirmed they were indeed ordering Keating's
4 product and were not confused in any way. (Keating SOF ¶ 75.) Indeed, the
5 fact that Keating had to tell the dentists that a competitor owned the mark
6 "BruxZir" just emphasizes that those dentists were not aware it was a trademark.

7 If Glidewell has to rely on its competitors to tell customers that
8 Glidewell's mark is a trademark, the term is obviously not functioning as an
9 indication of source. Such evidence only establishes the invalidity of
10 Glidewell's mark. The undisputed evidence establishes that dentists view the
11 term generically as the name of the product and not as an indication that
12 Glidewell is the source.

13 **b. Shaun Keating testimony**

14 Glidewell severely mischaracterizes Shaun Keating's deposition
15 testimony. (Mot. p. 8). On the pages cited, Mr. Keating actually testifies that
16 "BruxZir" is not seen by dentists as referring to Glidewell but rather to a "full
17 contoured monolithic zirconia crown for bruxers." (App. Ev., 85; 2nd
18 Jankowski Decl., Ex. 145 (Keating Dep Tr.) at 113:12 – 115:5). Indeed, a
19 reading of the complete testimony makes it abundantly apparent that Mr.
20 Keating, when he stated the word is not "used in any other way in the industry"
21 was referencing his preceding testimony that the mark was a generic term in the
22 industry for full monolithic zirconia crowns. *Id.* His response related to the
23 entire line of questions, not just the one immediately preceding it. This is
24 especially apparent as Mr. Keating had just made a clear statement contrary to
25 the assertion Glidewell now makes in its motion. *Id.*

26 **c. Bob Brandon testimony**

27 Glidewell is also severely mischaracterizing Mr. Brandon's testimony.
28 Although Mr. Brandon did testify that he knew that BruxZir was a trade name

1 of Glidewell, he also stated he could not testify as to what Dr. Nussear
 2 understood when he ordered a BruxZir zirconia crown from Keating. Mr.
 3 Brandon stated that he should have called the doctor to clarify because Keating
 4 was “getting sued over it.” (Mangum Decl., Ex 53 (Brandon Dep. Tr.), at
 5 48:17-20). So Mr. Brandon’s comment was directed to Keating’s policy after
 6 this suit was filed of calling dentists who wrote “bruxzir” on their prescription
 7 forms. It did not relate to any action by Keating in May 2011 as Glidewell is
 8 now claiming.

9 **d. Keating Internal Documents Do Not Establish That**
 10 **Glidewell’s Mark Is Protectable**

11 Keating references two documents that Keating’s personnel generated
 12 referencing the BruxZir mark as a “proprietary name.” (Mot. p. 9). Again,
 13 these documents, generated on October 18, 2011 and March 8, 2012,
 14 respectively, reference Keating’s policy after this suit was filed of calling
 15 dentists to confirm that they wished to order a Keating KDZ Bruxer crown. It
 16 does not establish that Glidewell has a protectable trademark. Rather as
 17 mentioned above, such efforts of subsequent remedial measures taken by a
 18 defendant to reduce potential liability are inadmissible. Fed. R. Evid. 407.

19 **6. Glidewell’s Declarations of Undisclosed Witnesses Are**
 20 **Inadmissible**

21 **a. Glidewell’s Reliance On Previously Undisclosed Dentist**
 22 **Testimony Is Improper**

23 During discovery, Glidewell failed to identify (1) any third party dentists
 24 to testify regarding their understanding of the BruxZir mark; (2) any survey data
 25 regarding third party dentists’ understanding of the mark; or (3) any expert
 26 witnesses to testify about survey data or dentists’ understanding of the mark.

27 Glidewell now relies upon the following untimely evidence in support of
 28 its motion:

- 1 • Seven declarations from dentist/customers of Glidewell first noticed by
2 Glidewell as witnesses in this case **seventeen minutes before Midnight**
3 **on Discovery Cutoff, October 29 2012** (Dr. Doneff; Dr. Newman; Dr.
4 Cohen; Dr. Luke; Dr. Bell; Dr. Toca; Dr. Michiels (*see* App. Evid. Exs.
5 A-F & Q).
- 6 • Expert opinion from Glidewell’s in-house dentist, Dr. DiTolla, notice of
7 which was received by Keating **nine minutes before Midnight on**
8 **Discovery Cutoff, October 29, 2012**; and
- 9 • Three expert reports received by Keating **seven minutes before**
10 **Midnight on Discovery Cutoff, October 29, 2012** (Franklyn rebuttal to
11 Boatright rebuttal; Franklyn rebuttal to Eggleston; Goldstein report

12 For many reasons the Court should not rely on any of this untimely
13 evidence. To the extent Glidewell wanted to rely upon these witnesses, it could
14 and should have identified them long ago.

15 i. **Glidewell’s Dentist Witness Testimony Is Not**
16 **Probative**

17 In any event, the seven dentist declarations and expert declarations
18 Glidewell relies upon in its motion [p. 9-10] are woefully insufficient to support
19 the validity of its mark. Evidence that a minority of persons use that term to
20 identify and distinguish one source cannot transform the term into a trademark.
21 Any such evidence that some buyers associate the term with a single source will
22 not change the result. Since, under the primary significance test, majority usage
23 defines the result, minority use of a term as a trademark cannot change generic
24 significance. MCCARTHY ON TRADEMARKS, 4TH EDITION, § 12:47 at 12-163. *In*
25 *re Recorded Books Inc.*, 42 U.S.P.Q.2d (BNA) 1275, 1997 WL 196608 (TTAB
26 1997) (“applicant’s evidence is [not] sufficient to show that the average
27 purchaser—as opposed to a small subset of purchasers—views RECORDED
28 BOOKS as a trademark for applicant’s goods.”); *Miller Brewing Co. v. Falstaff*

1 *Brewing Corp.*, 655 F.2d 5, 9, 211 U.S.P.Q. (BNA) 665, 668 (1st Cir. 1982);
 2 *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 374-275, 207 U.S.P.Q.
 3 (BNA) 465 (1st Cir. 1980 (“No amount of purported proof that a generic term
 4 has acquired secondary meaning associating it with a particular producer can
 5 transform the term into a registrable trademark. *Miller Brewing Co. v. Jos.*
 6 *Schlitz Brewing Co.*, 605 F.2d 990, 995, (7th Cir. 1979).

7 The dentists/declarants are also inadmissible to the extent they rely on
 8 hearsay statements of other dentists. (*See* Keating Objections to Evidence
 9 submitted herewith). The statements of the dentists/declarants are also not
 10 probative of the understanding of dentists generally, because this ‘sampling’ of
 11 dentists who are Glidewell customers suffers from a selection bias.

12 Glidewell has not satisfied its ultimate burden of proving its mark is
 13 protectable.

14 **ii. Glidewell’s Expert Testimony Is Not Probative**

15 With regard to expert disclosures, opening reports were due on September
 16 15, 2012 and rebuttal reports were due on October 15, 2012. Glidewell’s legal
 17 expert, Professor Franklyn, submitted an opening expert report on September
 18 15, 2012, but he did not submit a rebuttal report on October 15, 2012.
 19 Glidewell now seeks to rely on several new expert reports produced long after
 20 the deadlines. To the extent Glidewell wanted to rely upon the rebuttal reports
 21 of Professor Franklyn, DiTolla and Goldstein, it needed to submit timely reports
 22 by the deadlines. Keating had no opportunity to depose these witnesses on their
 23 late expert disclosures. Furthermore, opinions set forth in these untimely
 24 reports regarding dentists’ understandings or perceptions are not probative
 25 because they fail to follow rigorous standards required for admissible survey
 26 data. *See* 6 McCarthy § 32:158 at 32-341; *M2 Software, Inc. v. Madacy*
 27 *Entertainment*, 421 F.3d 1073, 1087 (9th Cir. 2005); *Hodgdon Powder Co., Inc.*
 28 *v. Alliant Techsystems, Inc.*, 512 F. Supp. 2d 1178 (D. Kan 2007).

1 **b. Glidewell Did Not Timely Disclose Dr. Goldstein And He**
 2 **Did Not Submit A Timely Expert Report**

3 Glidewell’s untimely disclosed dentist expert, Dr. Goldstein, was not
 4 disclosed to Keating until shortly before Midnight on the discovery cutoff, and
 5 he did not submit any timely report. Accordingly, particularly in view of the
 6 Court’s order denying extension of the case deadlines, Dr. Goldstein’s
 7 testimony is inadmissible. In any event, Dr. Goldstein’s testimony is not
 8 probative on the issue of validity of Glidewell’s mark. Dr. Goldstein states that
 9 “dentists would be able to identify the material in the product—zirconia—
 10 through the use of “Zir” as the second half of the brand name BruxZir.” (App.
 11 Evid., Ex. O, ¶ 17). Dr. Goldstein thus agrees that dentists would immediately
 12 understand that “Zir” means zirconia, without imagination or multistage
 13 reasoning. Dr. Goldstein further admits that the presence of “Brux” will cause
 14 dentists to think of bruxism. (*Id.*). Dr. Goldstein does not state that imagination
 15 or multistage reasoning is needed for dentists to think of bruxers, because no
 16 such reasoning is necessary. Glidewell’s in-house dentist, Dr. DiTolla (whose
 17 expert designation was also untimely), admits that the terms bruxer and bruxism
 18 are taught in dental school, and Dr. Goldstein likewise knows that dentists
 19 recognize the term immediately. (Keating SOF ¶ 5; App. Evid., Ex. O, ¶ 14.)

20 **c. Professor Franklyn’s Testimony Is Inadmissible Legal**
 21 **Opinion And His Untimely Report and Testimony**
 22 **Regarding Undisclosed Dentists Is Inadmissible**

23 Glidewell relies on the Declaration of David Franklyn, a law professor.
 24 In his declaration, Professor Franklyn repeats language from his untimely
 25 rebuttal reports where he claims to have interviewed 10 dentist witnesses who
 26 were not previously disclosed during the discovery period or in Franklyn’s
 27 initial report dated September 15, 2012, or in his deposition on October 12,
 28 2012. At his deposition, Franklyn testified repeatedly that he had never spoken

1 to a dentist or dental lab and had no experience in the dental industry. Indeed,
2 the only person Mr. Franklyn spoke to prior to submitting his September 15,
3 2012 report was Leonard Tachner, Glidewell's counsel. (2nd Jankowski Decl.,
4 Ex. 153 (Franklyn Dep. Tr.), at 29:11-17; 44-45; 96-97; 106-107; 133:6-8; 151-
5 152). Glidewell has not even attempted to show that Professor Franklyn's
6 untimely rebuttal reports were substantially justified or harmless as required by
7 Fed. R. Civ. P. 37(c)(1). (See Keating's Objections to Evidence submitted
8 herewith). Thus, the Franklyn Declaration is entirely improper and should be
9 excluded.

10 Moreover, the Franklyn Declaration repeats verbatim the text of his late
11 rebuttal reports submitted October 29, 2012. Both the Franklyn Declaration and
12 his rebuttal reports are inadmissible as untimely served, particularly in view of
13 the Court's denial of Glidewell's Ex Parte Application to Amend Scheduling
14 Order and extend discovery. Also, reports not timely provided under Rule 26(a)
15 are automatically excluded. See *Yeti by Molly, Ltd. v. Deckers Outdoor Corp.*,
16 259 F.3d 1101, 1106 (9th Cir. 2001); *Jarritos, Inc. v. Reyes*, 345 Fed. Appx.
17 215, 217 (9th Cir. 2009) (excluding expert witness reports produced after the
18 discovery deadline, even though they were central to party's case and exclusion
19 was highly prejudicial to proponent); *1st Source Bank v. First Resource Federal*
20 *Credit Union*, 167 F.R.D. 61, 64 (N.D. Ind. 1996); see also *Fu v. Owens*, 622
21 F.3d 880, 883-84 (8th Cir. 2010).

22 In addition, Professor Franklyn's testimony regarding previously
23 undisclosed dentists' recent understanding of the mark BruxZir lacks any
24 foundation, is blatant hearsay and is far outside the scope of his one and only
25 timely report served September 15. Professor Franklyn's testimony should also
26 be excluded because his legal opinions and conclusory testimony are
27 inadmissible under Fed. R. Evid. 702. (See Keating's Objections to Evidence
28 submitted herewith).

d. **Glidewell's Witness Testimony And Glidewell's
Marketing Practices Establish That BruxZir Identifies
The Product, Not Glidewell As The Source**

Glidewell has spent millions of dollars teaching the dental community that the BruxZir mark *is not an indication of Glidewell as the source*. Glidewell has done this, and continues to do this, in two ways: (1) through its sales of zirconia; and (2) through its naked licensing of the BruxZir mark for use with all-zirconia crowns sold by 180 dental laboratories that compete with Glidewell and Keating.

When applied to a dental restoration, the term BruxZir immediately conveys to dentists a zirconia product made to be used with bruxers. Glidewell has spent millions of dollars teaching dentists that BruxZir identifies *a type of crown*, rather than a source of crowns. This is reinforced by Glidewell's "authorized lab" program, which presents dentists with a large number of different dental laboratories competing to sell them their own BruxZir crowns. (Keating SOF ¶¶ 64-69). Just as dentists interpret a "gold crown" to mean a crown made from gold, and an "e.max crown" to mean a crown made from e.max, they interpret a "BruxZir crown" to mean a crown made from BruxZir (a ceramic zirconia).

There are presently about 180 dental labs across the U.S. that offer all-zirconia crowns for sale using Glidewell's mark BruxZir. (Keating SOF ¶¶ 64-66.) These labs are owned independently of Glidewell, and they compete with Glidewell (and Keating) to win the business of dentists. (Mangum Decl., Ex 50 (Shuck Dep. Tr.), at 130:7-15) To become "authorized," a dental lab needs to do only one thing: buy ceramic zirconia from Glidewell to use in making its all-zirconia dental restorations. Glidewell's General Counsel, Keith Allred, confirmed that the 180 authorized labs are authorized to use Glidewell's federally registered trademark on the crowns that the 180 labs sell. (Jankowski

Decl., Ex. 6 (Allred Dep. Tr.) at 141–142.) Glidewell does not monitor the authorized labs and does not perform any quality control over the crowns produced by the labs which the labs advertise as “BruxZir” crowns, without identifying Glidewell. (Keating SOF ¶ 68)

This reinforces for dentists receiving the materials that BruxZir is a name that identifies a *type of ceramic zirconia*, not a name that identifies a source of all-zirconia crowns. Indeed, the materials teach the dentists the opposite: that they can order a crown made of BruxZir zirconia from any of a long list of authorized laboratories. From the perspective of a dentist, the BruxZir name is not used in these materials to identify Glidewell as the source of the crown.

e. Undisputed Evidence Of Widespread Third Party Use Establishes Genericness Of Glidewell’s Mark

In addition to the third party uses of “brux” referenced in Keating’s Second Amended Answer and Counterclaims, and prior briefing, Keating has submitted with its Motion for Summary Judgment requesting cancellation of Glidewell’s registration, extensive undisputed evidence of widespread third party use of the terms “bruxer,” “brux,” “zir” and “bruxzir.” (Keating SOF 60-63, 76-78). Glidewell focuses only on the admittedly generic word “brux”. (Mot. At 13-14). Yet Glidewell has admitted that both “brux” and “zir” are immediately understood by dentists as meaning “brux” or “bruxism” and “zir” means “zirconia.” (Keating SOF 30-38). Glidewell has also admitted that “bruxer” is the generic term for the user of the crowns bearing the mark. (Keating SOF ¶¶ 43-46), and that Glidewell adopted the mark at least in part to connote a product useful for bruxers (Keating SOF ¶38). Thus the mark is generic as a matter of law. *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376 (Fed. Cir. 2007); *In re State Chemical Mfg. Co.*, 225 U.S.P.Q. (BNA) 687 (TTAB 1985); *In re Mortgage Bankers Association of America*, 226 U.S.P.Q. (BNA) 954 (TTAB 1985).

1 Glidewell has submitted no survey to rebut Keating's genericness
 2 evidence, its expert rebuttal reports and declarations are inadmissible, and the
 3 declarations of previously undisclosed dentist witnesses/Glidewell customers
 4 are also inadmissible. By contrast, Keating has submitted extensive undisputed
 5 evidence showing the generic use by dentists and dental labs of "brux" and "zir"
 6 as well as generic use of "bruxer" and "bruxzir."

7 Accordingly, summary judgment of genericness is appropriate and
 8 Glidewell's motion should be denied.

9 **C. Alternatively, The Undisputed Evidence Shows Glidewell's Mark Is**
 10 **Merely Descriptive and Lacks Secondary Meaning**

11 **1. If not Generic, BruxZir Is Merely Descriptive, Not Suggestive –**
 12 **No Mental Leap Is Required; Competitors' Need To Use Brux**
 13 **And Bruxer**

14 A term is suggestive if "imagination" or a "mental leap" is required in
 15 order to reach a conclusion as to the nature of the product being referenced.
 16 *Filipino Yellow Pages*, 198 F.3d at 1147. A term is descriptive if it
 17 communicates about a product without requiring any imagination on the
 18 consumer's part. *Survivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 632
 19 (9th Cir. 2005). Even if a word describes a single characteristic or property of a
 20 product, it can still be a descriptive mark. *CG Roxane*, 569 F. Supp. 2d at 1030.

21 Contrary to Glidewell's argument [Mot. At 14-18], no imagination or
 22 mental leap is necessary with BruxZir. Glidewell admits that dentists know
 23 what "brux" and "bruxer" means. They learn it early in dentistry school. Brux
 24 and Bruxer are both in the medical dictionary. Glidewell also admits that
 25 dentists know what Zir means. "It's "a crown for bruxers," (Keating SOF ¶ 33-
 26 34), "if you see brux or you identify somebody with brux or bruxism, think of
 27 zirconium. So we put brux and zir together." (Keating SOF ¶ 31). Glidewell's
 28 own witnesses testified that Glidewell specifically chose the mark because brux

1 stands for bruxism and zir for zirconia (Keating SOF 33-37). Dentists would
2 know what was in the product and what it was for. On top of that, the word is
3 pronounced exactly the same as “bruxer,” the type of patient who would use the
4 product. (Keating SOF ¶¶ 37-53).

5 Next, Glidewell argues that because the mark does not include the words
6 “crown” or “dental,” it must be suggestive rather than descriptive. (Mot. p. 15).
7 This shows a lack of understanding of suggestiveness/descriptiveness
8 classifications. By way of example, the word “gold” is obviously descriptive
9 (and even generic) for gold crowns, and porcelain-fused-to-metal is also
10 descriptive (and even generic) of PFM crowns. Nor does it matter that
11 Glidewell’s crowns may be used for patients other than bruxers. A mark need
12 not describe *every* use or user of a product to be descriptive of that product

13 Contrary to Glidewell’s claims, the evidence shows that not only do
14 Glidewell’s competitors need to use the terms brux and bruxer, they actually use
15 the terms currently. Glidewell points to Drake’s mark “ZIR-CAST” as a
16 competitive product. Even this single example actually does use half of the
17 mark—“Zir”. Moreover, Glidewell ignores the evidence of widespread
18 competitors’ use of brux, bruxer and zir, even those to which Glidewell itself
19 sent cease and desist letters. (SOF ¶ 60-63). Therefore, contrary to Glidewell’s
20 arguments, the “Competitors’ Needs” test does not support a finding of
21 suggestiveness because Glidewell’s competitors do indeed need and use the
22 terms at issue to describe their own products.

23 Glidewell did not coin the word “bruxer,” which has existed for decades
24 as a generic term identifying the intended user of Glidewell’s products. Rather,
25 Glidewell knowingly adopted a misspelling of a generic word for its mark.
26 Thus, at a minimum, Glidewell’s mark is merely descriptive.

27 ///

28 ///

1 **2. Glidewell Has Failed To Prove Secondary Meaning**

2 “Saying that a trademark has acquired “secondary meaning” is shorthand
3 for saying that a descriptive mark has become sufficiently distinctive to
4 establish “a mental association in buyers’ minds between the alleged mark and a
5 single source of the product.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S.
6 763, 769, 112 S. Ct. 2753 (1992); *Japan Telecom*, 287 F.3d at 875 (“To take a
7 descriptive term out of the public domain, a plaintiff must demonstrate that the
8 relevant buying public accords it secondary meaning”); *Retail Servs.*, 364 F.3d
9 at 539; MCCARTHY ON TRADEMARKS, 4TH EDITION, § 15:5. Glidewell “is
10 not entitled to a presumption of secondary meaning unless the Trademark
11 Examiner required proof of secondary meaning as part of the application for
12 registration of the mark. *Zobmondo Entm’t*, 602 F.3d at 1114, citing
13 *PaperCutter, Inc. v. Fay’s Drug Co.*, 900 F.2d 558, 564 (2d Cir. 1990) (“[The]
14 burden [to prove secondary meaning] does not shift upon a decision of the
15 [PTO] to register the mark, absent evidence that the [PTO] registered the mark
16 upon finding that it had acquired secondary meaning.) The Trademark
17 Examiner did not require such proof. Thus, because, at a minimum, Glidewell’s
18 mark is merely descriptive, Glidewell must satisfy its burden of proving
19 secondary meaning in the mark. When descriptive marks are especially “weak,”
20 as here, the law requires a “strong showing of strong secondary meaning.”
21 *Japan Telecom*, 287 F.3d at 873 (citing *Filipino Yellow Pages*, 198 F.3d at
22 1151).

23 The critical date for establishing secondary meaning is May 2011, when
24 Keating first entered the market with its KDZ Bruxer product. *Sand Hill*
25 *Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp. 2d 1107, 1117 (N.D.
26 Cal. 2010) (citing *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th
27 Cir. 1985) (en banc)). Glidewell’s advertising and marketing efforts and
28 expenses after that date are irrelevant. *Id.*

1 **3. Glidewell's Untimely Disclosed Dentist Witnesses' Testimony Is**
 2 **Inadmissible And Should Be Disregarded**

3 Glidewell relies upon declarations of seven dentists (Memo p. 20; SUF
 4 33), all Glidewell customers who have as recently as October 2012 toured
 5 Glidewell's facility. None of these witness names were disclosed to Keating
 6 during discovery. Glidewell has offered no excuse for its failure to disclose the
 7 witness names, nor for its legal expert Professor Franklyn's failure to disclose
 8 them in his expert report or during his deposition. Accordingly, for this and
 9 other reasons stated in Keating's Objections to Evidence, the dentists' testimony
 10 is inadmissible, particularly in view of the Court's denial of Glidewell's *Ex*
 11 *Parte* Application to extend discovery.

12 In any event, none of these witnesses provide any evidence of their
 13 perception that, as of May 2011, the primary significance of Glidewell's
 14 BruxZir mark was to indicate Glidewell as the exclusive source of dental
 15 crowns bearing that mark. Moreover, the dentists' testimony is based on their
 16 existing relationship with Glidewell and is therefore not persuasive evidence
 17 that a significant number of consumers have formed a similar mental
 18 association. *Japan Telecom*, 287 F.3d at 874-75 (finding unpersuasive six
 19 declarants who were familiar with plaintiff: "Every small business with a
 20 descriptive name can point to at least a few former customers who remember its
 21 name . . . None of that means that the relevant buying public makes the same
 22 association.") In addition, the dentists' statements that they have spoken to
 23 other (unspecified) dentists who identify BruxZir with Glidewell lack
 24 foundation and constitute hearsay. *Id.* at n. 1.

25 **4. Glidewell's Advertising Teaches That BruxZir Is A Type Of**
 26 **Material, Not A Source**

27 As discussed above, Glidewell's marketing efforts have actually served to
 28 disprove secondary meaning in the mark. Glidewell's advertising and

1 promotion teaches the dental community that the BruxZir mark *is not an*
 2 *indication of Glidewell as the source*. Glidewell has done this, and continues to
 3 do this, in two ways: (1) through its sales of zirconia; and (2) through its naked
 4 licensing of the BruxZir mark for use with all-zirconia crowns sold by 180
 5 dental laboratories that compete with Glidewell and Keating.

6 In addition, Glidewell's own promotional materials and Dr. DiTolla's
 7 videos compare "bruxzir" or "bruxer" crown to a gold crown and porcelain
 8 fused to metal crown. (Keating SOF 55). These are generic names for types of
 9 crowns with which dentists are very familiar. (Keating SOF 56). Glidewell
 10 also uses the word BRUXZIR as a noun and plural noun, which is further
 11 evidence of generic use. (Keating SOF 57). Dr. DiTolla even states in his
 12 videos that one could even get "a couple of Bruxzirs put in." (Keating SOF 58)
 13 and uses "BruxZir crown" and "full-contour zirconia" interchangeably for
 14 educational purposes. (Keating SOF 59).

15 **5. Glidewell's Length and Manner Of Use of BruxZir Disproves** 16 **Secondary Meaning**

17 Being first to market with a product does not render the product's name
 18 distinctive. *See In re Phoseon Tech. Inc.*, 103 U.S.P.Q. 2d (BNA) 1822 (TTAB
 19 2012). Secondary meaning must be established through evidence existing at the
 20 time the alleged infringer began using the allegedly infringing mark. *Sand Hill*
 21 *Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp. 2d 1107, 1117 (N.D.
 22 Cal. 2010) citing *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th
 23 Cir. 1985) ("Consequently, only evidence showing use of the mark . . . prior to
 24 Defendant's [allegedly infringing] use of the mark is probative of secondary
 25 meaning.")

26 At the time Keating began selling its KDZ Bruxer product in May 2011,
 27 Glidewell had used the BRUXZIR mark for less than two years. Moreover, in
 28 this very short time, numerous third parties were already using the terms "brux,"

1 “zir,” “bruxer” and “bruxzir” in connection with all zirconia crowns. This short
 2 period, coupled with the evidence of non-exclusive use, renders it further
 3 unlikely that Glidewell developed any appreciable secondary meaning. See
 4 *Nartron Corp.*, 305 F.3d at 405, cert denied, 538 U.S. 907, 123 S.Ct. 1486, 155
 5 L.Ed.2d 227 (2003).

6 **6. Glidewell’s Use Of The Mark Has Not Been Exclusive**

7 Glidewell relies on the Franklyn declaration for the statement that
 8 “BruxZir mark does not exist in a crowded field of similar marks.” (Mot. At
 9 24). Even if admissible (which is denied), Professor Franklyn’s declaration
 10 ignores the undisputed evidence of widespread third party use and registration
 11 of marks including “brux,” “zir” and “bruxer” and “bruxzir”. He also ignored
 12 the evidence of phonetic equivalence of the mark BruxZir with bruxer, the
 13 intended user of Glidewell’s crowns. At his deposition, Professor Franklyn
 14 testified that he had no dental industry experience, had not read any dental
 15 industry journals and had never spoken to a dentist in connection with this case.
 16 (*see* Objections to Franklyn Evidence submitted herewith; 2nd Jankowski Decl.,
 17 Ex. 153).

18 Glidewell’s reliance on its cease and desist letters for evidence of secondary
 19 meaning is also misplaced. (Mot. at 24). Glidewell’s own cease and desist letters
 20 state that “BRUXZIR and BRUXER sound the same.” (Keating SOF 52). The
 21 undisputed evidence establishes that Glidewell’s use of its mark has not been
 22 exclusive, even in the short time between launch of its BruxZir crowns in June
 23 2009 and Keating’s first sales of KDZ Bruxer crowns in May 2011.

24 **IV. CONCLUSION**

25 For the foregoing reasons, Keating respectfully requests that the Court
 26 deny Glidewell’s motion and, instead, enter judgment in favor of Keating on
 27 Keating’s Motion for Summary Judgment of Cancellation of Glidewell’s
 28 Trademark Registration.

Respectfully submitted,

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Dated: November 26, 2012_ By: /s/ Lynda J. Zadra-Symes

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